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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86139330
Applicant	Clemente Ayala
Applied for Mark	SUPERMERCADOS TELOLOAPAN
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Submission	Applicants Request for Remand and Amendment
Attachments	Monty_0001_Request_for_Remand.pdf(159410 bytes ) Exhibit A.pdf(189587 bytes ) Exhibit B.pdf(2274010 bytes )
Filer's Name	JL Jennie Salazar
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Signature	/JL Jennie Salazar/
Date	05/24/2016

**THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: Clemente Ayala  
Serial No.: 86139330  
Filed: December 10, 2013  
Mark: SUPERMERCADOS TELOLOAPAN  
Our Ref#: Monty 0001-T0001

**REQUEST FOR REMAND TO THE EXAMINING ATTORNEY**

Pursuant to TBMP § 1209.04, Clemente Ayala (“Applicant”) respectfully requests that the above-referenced Application be remanded to the Examining Attorney on the ground that the Applicant has new evidence that was not available prior to the filing of the Notice of Appeal. Applicant submits that it has good cause as established under the guidelines of TBMP § 1207.02:

Because a consent agreement offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board’s final decision on the appeal.

**I. BACKGROUND**

Registration of the above-referenced Application was refused under Section 2(d) of the Trademark Act on the basis of likelihood of confusion with Registration Number 2791895 for the mark TELOLOAPAN for the following good in class 30: “mole paste, pipian paste, adobo paste, Mexican sauces, candies, cookies, biscuits, honey, flour tortillas, corn tortillas, and chocolate” (the “’895 Registration”). A copy of the ‘895 Registration is attached as Exhibit A.

## II. NEW EVIDENCE

Pursuant to TBMP 1207.02 (1), Applicant submits that good cause for remand can be demonstrated by the following evidence that was not previously available:

1. **Signed Co-Existence Agreement** – Applicant seeks remand to submit the Co-Existence Agreement dated May 24, 2016 between Applicant and Bueno Alimentos, S.A. DE C.V. Corporation, owner of the '895 Registration (the “Registrant”). A copy of the Co-Existence Agreement is attached as Exhibit B.

Subsequent to the filing of the Notice of Appeal, the Applicant and Registrant conferred regarding their respective marks for their respective goods. Registrant uses the mark TELOLOAPAN for mole paste. *See* Exhibit A. Applicant applied to register the mark SUPERMERCADOS TELOLOAPAN for supermarkets and retail grocery stores.

After due consideration, the parties have agreed that Applicant’s use of its mark SUPERMERCADOS TELOLOAPAN for supermarkets and retail grocery stores, would not be confused with the mark TELOLOAPAN for mole paste. The goods and services as offered and sold are sufficiently different that there is no likelihood that their respective customers would be confused by their concurrent use. Additionally, Applicant and Registrant expressly consent to the use and registration of Applicant’s SUPERMERCADOS TELOLOAPAN mark, and have taken measures, such as use of their respective marks and trade dress, to prevent confusion by the public. *See*, e.g., paras. 3-4 of Exhibit B.

The Court of Appeals for the Federal Circuit has held that a consent agreement such as the one submitted here, which sets forth fully the reasons why confusion would not be likely, is entitled to great weight in considering the issue of likelihood of confusion as “it can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in

causing public confusion.” *In re N.A.D., Inc.*, 754 F.2d 996, 224 U.S.P.Q. 969 (Fed. Cir. 1985). A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.” *In re N.A.D.* quoting *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 568 (CCPA 1973). Thus, it is respectfully requested that remand be granted to permit consideration of the Co-Existence Agreement (Exhibit B).

2. **Statements of Peaceful Co-Existence** – Applicant also requests remand to enter evidence of confirmation by the Applicant and the Registrant of the peaceful co-existence of their respective marks for more than fifteen (15) years. *See* Exhibit B, p. 1.

3. **Change in Goods/Services of the ‘895 Registration** – Applicant also requests remand to enter evidence of the corrected USPTO identification of goods and services for the ‘895 Registration. On Dec. 7, 2009, the Registrant filed an 8&15 Declaration removing all goods/services, except mole paste. According to the Office Action dated October 30, 2014, “until such time as the Office records are formally corrected for Registration No. 2791895, the refusal is continued based on the identification presently of record.” *See*, Office Action mail-dated October 30, 2014. The USPTO has since corrected the identification of goods and services for the ‘895 Registration to: “IC 030. US 046. G & S: Mole paste [, **pipian paste, adobo paste, mexican sauces, candies, cookies, biscuits, honey, flour tortillas, corn tortillas, and chocolate** ].” *See*, Exhibit A.

The USPTO correction in registration was not made effective until the case was placed on appeal. The statements by the Examining Attorney in the Office Action of October 30, 2014 indicate that such evidence was not considered and was at least part of the basis for denial of the pending application. Now that such correction has been made and this evidence is now available, such evidence is relevant to the 2(d) rejection and should be considered.

4. **Geographical Significance** – It is presumed that previous rejections for geographical significance of the word “TELOLOAPAN” have been withdrawn. In the event any such rejections may be raised, Applicant seeks remand to enter evidence in support of lack of descriptive or geographic significance of “TELOLOAPAN”. Applicant seeks to present evidence of new case law decided January 15, 2015, namely *In re The Newbridge Cutlery Co.*, Appeal No. 2013-1535, 113 USPQ 2d. 1445 (Fed. Cir. Jan. 15, 2015) (finding of lack of geographical descriptiveness where a name of a place is not generally known to the purchasing public in the US). Applicant is aware of no evidence presented in this case indicating that TELOLOAPAN is a place generally known to the purchasing public.

### **III. NEW ATTORNEY OF RECORD**

Pursuant to TBMP 1207.02 (2), Applicant further submits that good cause for remand can be found where, as here, Applicant has a new attorney of record, namely Jennie Salazar. Applicant’s new attorney of record seeks the opportunity to submit the evidence provided herein.

### **IV. CONCLUSION**

On April 22, 2016, Applicant filed a request for extension of time which was granted, bringing the time to respond to May 25, 2016. This Request for Remand is timely filed as Applicant has not yet filed an appeal brief, the Board has not rendered its final decision on the appeal, and Applicant has submitted this Request within the time to respond. Further action on the appeal should be suspended while this Request for Remand is pending and the additional evidence is reviewed by the Examining Attorney.

In light of the clear defenses provided by the evidence above, it is respectfully submitted that the case be remanded to the Examining Attorney so that the refusal to register may be withdrawn and the mark allowed for publication.

Dated: May 24, 2016

Respectfully submitted,

By: /Jennie Salazar/  
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# TEOLOAPAN

**Word Mark** TEOLOAPAN**Goods and Services** IC 030. US 046. G & S: Mole paste [, pipian paste, adobo paste, mexican sauces, candies, cookies, biscuits, honey, flour tortillas, corn tortillas, and chocolate ]. FIRST USE: 20030630. FIRST USE IN COMMERCE: 20030630**Mark Drawing Code** (1) TYPED DRAWING**Serial Number** 76154821**Filing Date** October 27, 2000**Current Basis** 1A**Original Filing Basis** 1B**Published for Opposition** May 21, 2002**Registration Number** 2791895**Registration Date** December 9, 2003**Owner** (REGISTRANT) BUENO ALIMENTOS, S.A. DE C.V. CORPORATION MEXICO CARRETERA MONTERREY-SALTILLO KM. 3.5 BODEGAS 3 Y 4 SANTA CATARINA, NUEVO LEON C.P. 66350 MEXICO

**Attorney of Record** Clyde Pine  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130604.  
**Renewal** 1ST RENEWAL 20130604  
**Live/Dead Indicator** LIVE

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## **TRADEMARK CO-EXISTENCE AGREEMENT**

This Trademark Co-Existence Agreement ("Agreement") is made, entered into, and shall be effective as of the date of the last signature below, by and between Clemente Ayala, an individual residing at 5330 Chimney Rock, Houston, Texas 77081 ("Ayala") and Bueno Alimentos, S.A. DE C.V. Corporation, a Mexico Corporation with its principal place of business at 3.5 Bodegas 3 Y 4 Santa Catarina, Nuevo Leon C.P. 66350 Mexico ("Bueno Alimentos"). Ayala and Bueno Alimentos are sometimes referred to herein individually as "Party" and collectively as "Parties."

### **RECITALS**

WHEREAS, Ayala has adopted and uses the trademark "SUPERMERCADO TELOLOAPAN" and Bueno Alimentos has adopted and uses a trademark that includes the word "TELOLOAPAN" (collectively the "Marks");

WHEREAS, Ayala and Bueno Alimentos are of the opinion and believe that their respective goods and services as offered and sold under their respective Marks, are sufficiently different that there is no likelihood that their respective customers will be confused by their concurrent use of their respective Marks;

WHEREAS, the Parties' respective Marks have been used simultaneously for more than fifteen (15) years without any known instances of customer confusion; and

WHEREAS, the parties desire to provide for their use and registration of their respective Marks throughout the world under the terms and conditions of this Agreement and to provide a basis for minimizing the possibility of confusion.

NOW THEREFORE, in consideration of the foregoing recitals and mutual covenants set out herein, the Parties agree as follows:

1. The "Ayala Mark" means the SUPERMERCADO TELOLOAPAN mark, serial number 86139330, filed on December 10, 2013, and used with Ayala's chain of stores.

2. The "Bueno Alimentos Mark" means the TELOLOAPAN mark, serial number 76154821, registered on December 9, 2003, and used with Bueno Alimentos' mole paste.

3. Ayala agrees not to adopt or use any mark that includes the word "Teloloapan" in conjunction with mole paste. Ayala also agrees not to use the word Teloloapan in trade dress which includes a colored shield with white writing. Ayala also agrees to use the word Teloloapan only in conjunction with the word "Supermercado" as follows: "Supermercado Teloloapan."

4. Bueno Alimentos agrees not to adopt or use any mark that includes the word "Teloloapan" in conjunction with goods and/or services relating to supermarkets and retail stores. Bueno Alimentos also agrees not to use the word Teloloapan in a mark in conjunction with the word "Supermercado", "supermarket" or any variation of the word "store". Bueno Alimentos also agrees that, when using the mark "Teloloapan" in connection with its goods, it agrees to use such word in white font against a colored shield.

5. Provided that Bueno Alimentos is in compliance with the terms of this Agreement, Ayala agrees not to oppose the registration or seek cancellation of, or otherwise challenge Bueno Alimentos' right to use its Bueno Alimentos Mark, and further will not assert the Ayala Mark against Bueno Alimentos, its distributors, its customers, or end users of Bueno Alimentos' products and services.

6. Provided that Ayala is in compliance with the terms of this Agreement, Bueno Alimentos agrees not to oppose the registration or seek cancellation of, or otherwise challenge Ayala's right to use his Ayala Mark, and further will not assert the Bueno Alimentos Mark against Ayala, his distributors, his customers, or end users of Ayala's products and services.

7. Ayala and Bueno Alimentos agree to take reasonable measures under the circumstances to market and promote their respective goods and services under their respective Marks in such a way as to mitigate any likelihood of confusion between them. Bueno Alimentos agrees to use the word "teloloapan" in combination with the word "mole" in product labels and advertisements for its mole products. Alaya agrees to use the word combination "supermercado teloloapan" in connection with its stores. The parties agree that this use would further prevent likelihood of confusion to its customers. In the unlikely event that confusion occurs, the parties agree to notify each other of the confusion in writing, and to take adequate measures to prevent the likelihood of further confusion.

8. This Agreement shall be effective worldwide in all jurisdictions where the parties' respective Marks confront each other through use, application, or registration, now or in the future.

9. Ayala and Bueno Alimentos agree to sign such further documents and agreements as may be consistent with and reasonably necessary to effect the intent of this Agreement, such as any necessary consent agreements to obtain registration of their respective Marks.

10. This Agreement shall inure to the benefit of and be binding and enforceable against each of the parties' affiliates, officers, agents, servants, employees, members, privies, successors, and assigns.

11. Ayala and Bueno Alimentos each represent and warrant, as of the date hereof, that they have all requisite power and authority to enter into this Agreement and to perform all of their respective obligations hereunder.

12. If any provision of this Agreement is deemed unenforceable under applicable law by a court having jurisdiction, such provision will be unenforceable only to the extent necessary to make it enforceable without invalidating the remainder thereof or any of the remaining





provisions of this Agreement. If the provision cannot be amended to make it enforceable, such invalidity or illegality shall not invalidate the whole of this Agreement, but rather, the Agreement shall be construed as if it did not contain the invalid or illegal part, and the rights and obligations of the Parties shall be construed and enforced accordingly.

13. This Agreement may be executed in multiple counterparts. All such counterparts, when so executed, shall be deemed to constitute one final Agreement as if one document had been signed by all Parties to this Agreement. Each such counterpart, upon execution and delivery of all counterparts, shall be deemed to be a complete and original of this Agreement. A telecopy, facsimile, or other electronic transmission of a signed counterpart of this Agreement shall be sufficient to bind the party or parties whose signature(s) appear thereon.

14. This Agreement is governed by and will be construed, interpreted and the rights of the parties determined in accordance with the laws of the Laws of the United States and the State of Texas without regard to principles of conflicts of law. This agreement shall be governed by and interpreted in accordance with the laws of the state of Texas.

P1

SIGNED this 24 day of May 2016

CLEMENTE AYALA

By: \_\_\_\_\_

Printed Name: \_\_\_\_\_

Its: \_\_\_\_\_

SIGNED this 18 day of May 2016

BUENO ALIMENTOS, S.A. DE C.V.  
CORPORATION

By: \_\_\_\_\_

Printed Name: \_\_\_\_\_

Its: \_\_\_\_\_